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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,764	05/04/2001	Sakae Ishikawa	207187US2	7828

22850 7590 04/17/2003

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EXAMINER

BUTLER, MICHAEL E

ART UNIT PAPER NUMBER

3653

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/848,764

Applicant(s)
Ishikawa et al.

Examiner
Michael E. Butler

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3653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 31, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION***Election/Restriction***

1. A restriction requirement and election of species requirement were mailed on 10/2/02. Applicant responded with a restriction election and a provisional species requirement premised upon the original species requirement. Applicant advanced the position that there were four species rather than five and that claim 1 was generic to all species. Examiner concurred accepted what he perceived to be applicant's four species identification and generic claim identification. The examiner prepared a response mid-December for mailing after a proofreading and comparison of applicant's species upon examiner's return from vacation. On December 24, applicant submitted a change of address. While the examiner was on vacation, the clerical staff collected the case file to enter the change of address, and upon seeing a near ready office action, they mailed the action on December 31. Applicant responded on 1/31 to a mailing with a provisional election with traverse to the restriction requirement and a provisional election with traverse to the species requirement, incorporating by reference his previous arguments.

As the case file was not prepped by the examiner for mailing, examiner is unsure whether the 12/31 mailing included the mid-December written action, a copy of the October action, or both. Examiner suspects applicant received both and applicant's small figure characterization change identified suggests he was looking at the newer paper while reviewing the figures, and applicant's traversal without a new argument of the earlier species traverse suggests he was looking at a re-mailed copy of the October requirement while looking at the claim groupings (as the examiner adapted and concurred with what examiner perceived as applicant's species delineations, if applicant disagreed

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with the new species requirement, a traversal of a new four species requirement would necessarily present a new argument addressing the differing four species election rather than a reiteration of the arguments directed at a five species groupings).

In the interest of clarity as to what the dispute is, a new restriction requirement is submitted based on what examiner had intended for mailing in early January after review and comparison to the specification and election.

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: The first embodiment, as shown in figures 1-5 drawn to a method and apparatus for simultaneously carrying out deliver of a new product and collection of an old product, of the same type product to and from a same location.

Species II: The second embodiment, as shown in figures 6-7 drawn to a method and apparatus for carrying out deliver of a new product and collection of an old product, of the same type product to and from a same location but at differing times.

Species III: The third embodiment, drawn to a method and apparatus for carrying out deliver of a new product and collection of an old product, of differing type products.

Species IV: The fourth embodiment as shown in figures 8 drawn to a method and apparatus for carrying out deliver of a new product and collection of an old products to and from a differing locations.

3. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claim 1 appears to be generic.

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Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Applicant has presented an argument that if claim 1 is allowable, all non-elected claims ought be allowable. This argument relates to rejoinder of non-elected claims. A general attribute of dependent claims is that they contain the limitations of their base claims. If the base claim(s) define over the prior art, the dependent claim(s) define over that same art without examination, so rejoinder of the claims occurs (excepting such situations as the base claim chronologically overcoming the prior art via a 131 affidavit or CIP continuity link in which subsequently invented dependent claims fail to overcome the intervening prior art, or rolling of elected group special technical features into a base claim in a manner such as destroy compatibility of the nonelected and amended base claims under 35 USC 112).

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-38 drawn to a conveyor control system classified in class 700 subclass 230.
- II. Claims 39-71 drawn to a method and apparatus for storing and transporting articles to horizontally static structure , classified in class 108, subclass 55.1.

6. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if

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they are shown to be separately usable. In the instant case, invention I has separate utility such as to a system for sorting and retrieving items remotely housed from a point of sale terminal. See MPEP § 806.05(d). In the instant case, invention II has separate utility such as storing clothing. See MPEP § 806.05(d).


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

Michael E. Butler

Examiner


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
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